



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/458,646	12/09/1999	RICHARD S. SCHWERDTFEGER	AT9-99-732	9114

35617 7590 07/31/2003

CONLEY ROSE, P.C.
P.O. BOX 684908
AUSTIN, TX 78768

[REDACTED] EXAMINER

QUELER, ADAM M

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 07/31/2003

✓

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	09/458,646	SCHWERDTFEGER ET AL.
	Examiner Adam M Queler	Art Unit 2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 07 February 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-39 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 38 and 39 is/are allowed.

6) Claim(s) 1-12, 14-20, 22-27, 30 and 32 is/are rejected.

7) Claim(s) 13, 21, 28, 29 and 31 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 09 December 1999 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,3</u> .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. This action is responsive to communications: Application and IDS filed 12/9/1999, and IDS filed 1/22/2002.
2. Claims 1-39 are pending in the case. Claims 1, 14, 22, 27, 30, 32, and 37-39 are independent claims.
3. The applicant is required to update the serial numbers and status of related applications as disclosed on page 1 of the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Although, the formats claimed in claim 4 are mentioned the specification. The specification discloses an invention that relies heavily on DOM trees, which were known to interact with HTML/XML documents. It is not apparent from the specification how one of ordinary skill in the art would adapt these claimed formats to work with a DOM tree, or the instant invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 1-4, 6-12, 14-20, 22-27, 30, 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raman (USPN 5748186—patented 5/5/1998) and further in view of “Extensible Server Pages (XSP) Layer 1” by Stefano Mazzocchi (published 6/11/99).**

Regarding independent claim 1, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3). Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a variable name, or a memory location. Raman does not explicitly disclose producing a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a second digital format, including a portion of an original document expressed in a second digital format, with identifiers for elements (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects.

Regarding dependent claim 2, Raman teaches storing the element (col. 4, ll. 48-49), and inherently the identifier as described in claim 1.

Regarding dependent claim 7, Raman teaches forming a model of a logical structure of the document (col. 4, ll. 55-64). Raman does not explicitly disclose translating a corresponding

script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, of a DOM tree (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects. It would have been further obvious to provide the script so that it could be used.

Regarding dependent claim 10, Raman teaches a client (col. 3, ll. 66-67). Raman also teaches using the script to present the document (col. 3, ll. 8-11).

Regarding dependent claim 11, Raman teaches generating an event in response to user input (col. 6, ll. 30-32). Raman also teaches associating the event with an element (col. 7, ll. 33-43). Raman does not teach providing the event and the identifier to the transcoded though it would have been obvious to do so that the event could be properly transcoded.

Regarding independent claim 14, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3). Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a variable name, or a memory location. Raman teaches forming a model of a logical structure of the document (col. 4, ll. 55-64). Raman teaches a client (col. 3, ll. 66-67). Raman does not explicitly disclose translating a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, of a DOM tree (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects. It would have been further obvious to provide the script so that it could be used.

Regarding dependent claim 15, Raman teaches using the script to present the document (col. 3, ll. 8-11). Raman teaches generating an event in response to user input (col. 6, ll. 30-32). Raman also teaches associating the event with an element (col. 7, ll. 33-43). Raman does not teach providing the event and the identifier to the transcoded though it would have been obvious to do so that the event could be properly transcoded.

Regarding dependent claims 12 and 20, Raman teaches accessing the model for usage (cols 6-7). This inherently must be done with an identifier. Raman teaches transcoding the document (col. 3, ll. 8-11)). Raman does not teach producing the script. Mazzocchi teaches transcoding a model (p. 6). Mazzocchi teaches producing a script based on the modified document (p. 7-8). Mazzocchi teaches transmitting through an http servlet, which inherently would provide to a client machine.

Regarding independent claim 22, the transcoder proxy comprising the system of claim 14 is rejected under the same rationale.

Regarding dependent claim 23, Raman teaches receiving access commands, used for accessing (col. 7), and providing in the first format (col. 7, ll. 50-58).

Regarding dependent claim 24, Raman teaches transcoding the document (col. 3, ll. 8-11). Raman does not teach producing the script. Mazzocchi teaches transcoding a model (p. 6). Mazzocchi teaches producing a script based on the modified document (p. 7-8).

Regarding dependent claims 4, 19, and 26, Raman teaches the first format is HTML (col. 3, ll. 40-42).

Regarding independent claim 30, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3).

Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a variable name, or a memory location. Raman teaches forming a model of a logical structure of the document (col. 4, ll. 55-64). Raman teaches a client (col. 3, ll. 66-67). Raman teaches an output device and a user agent configured to receive a script, which includes an element and inherently an identifier (FIG. 1). Raman teaches providing output commands to the output device (col. 3, ll. 8-16). Raman does not explicitly disclose translating a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, of a DOM tree (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects. It would have been further obvious to provide the script so that it could be used.

Regarding independent claim 32, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3). Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a variable name, or a memory location. Raman teaches forming a model of a logical structure of the document (col. 4, ll. 55-64). Raman does not explicitly disclose translating a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, of a DOM tree (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text

script then data objects. It would have been further obvious to provide the script so that it could be used.

Regarding dependent claims 8, 16 and 33, Raman teaches methods for access and manipulating the document (cols. 6-7).

Regarding dependent claims 9, 17, and 34, Raman teaches the model is made up out of document object (col. 4, ll. 61-62), and is therefore a document object model.

Regarding dependent claims 3, 18, 25, and 35, Raman discloses the first format is a text based markup language (col. 3, ll. 40-42).

Regarding dependent claims 6 and 36, Raman does not explicitly disclose translating a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, including a portion of an original document expressed in a second digital format, with identifiers for elements (p. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects.

Regarding independent claim 37, Raman discloses receiving the document in a first digital format (col. 4, ll. 39-34). Raman teaches that these documents will include an element (FIG. 3). Raman teaches the elements are stored within a data structure (col. 4, ll. 48-49). Inherently, to be stored in a computer system they must be given some type of unique identifier for example, a variable name, or a memory location. Raman teaches forming a model of a logical structure of the document (col. 4, ll. 55-64). Raman does not explicitly disclose translating a corresponding script but does disclose methods for use in such a script (cols. 6-7). Mazzocchi teaches a script representation, of a DOM tree (p. 7-8). It would have been obvious to one of ordinary skill in the

art at the time of the invention to combine Mazzocchi and Raman as it is easier to transmit a text script then data objects. It would have been further obvious to provide the script so that it could be used.

Raman teaches generating an event in response to user input (col. 6, ll. 30-32). Raman also teaches associating the event with an element (col. 7, ll. 33-43). Raman does not teach providing the event and the identifier to the transcoded though it would have been obvious to do so that the event could be properly transcoded.

Raman teaches accessing the model for usage (cols 6-7). This inherently must be done with an identifier. Raman teaches transcoding the document (col. 3, ll. 8-11)). Raman does not teach producing the script. Mazzocchi teaches transcoding a model (p. 6). Mazzocchi teaches producing a script based on the modified document (p. 7-8). Mazzocchi teaches transmitting through an http servlet, which inherently would provide to a client machine.

8. **Claim¹⁵ 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raman and Mazzocchi, further in view of Applicant's Admitted Prior Art.**

Regarding dependent claim 5, Raman and Mazzocchi are silent as to PDF, AFP, and postscript documents. Applicant admits that these formats were well-known digital formats (p. 17-19). It would have been obvious to one of ordinary skill in the art at the time of the invention to include these formats so more types of documents could be used with the invention.

Allowable Subject Matter

9. Claims 13, 21, 28-29, and 31, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 38 and 39 are allowed.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (703) 308-5213. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5631.

AQ
July 10, 2003

Heather Herndon
HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100